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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/051,641	01/18/2002	Nikolaus Z. Schwabe	L7059-0001	8057
7590	06-17/2004			
Michael L. Diaz Michael L. Diaz, P.C. Suite 200 555 Republic Drive Plano, TX 75074			EXAMINER MCKANE, ELIZABETH L	
			ART UNIT	PAPER NUMBER
			1744	
DATE MAILED: 06/17/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/051,641

Applicant(s)

SCHWABE, NIKOLAUS Z.

Examiner

Leigh McKane

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13 and 14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13 and 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>In re Ngai decision</u> |

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 13 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Rohowet (U.S. Pat. 4,188,437).

With respect to the rejection of claims 13 and 14 under 35 U.S.C. 102(b), the phrases "the first indicator providing a value of postage paid" and "establishing a value of postage paid" are not given any patentable weight (see M.P.E.P. 706.03(a)) as being directed solely to printed matter. Rohowetz discloses adhesive tapes that change color in the presence of water or steam at an elevated temperature and are useful as sterilization indicators. The tapes comprise an adhesive layer and a polymeric base film containing on one surface thereof a coating of a thermotropic ink comprising a binder resin, a colorant which undergoes a color change in the presence of water or steam at elevated temperature, and a solvent blend. The adhesive is present on the back surface of the tapes and is used for affixing the indicator tapes to various surfaces. The colorant is located on the outer surface and is selected to produce a visible color change upon exposure to water or steam at elevated temperature (see column 2, lines 5-41).

With respect to the rejection of claims 13 and 14 under 35 U.S.C. 103(a), Rohowetz teaches that while the tapes are designed primarily as sterilization indicators, they may provide other functions as well. For example, the tape may be printed to incorporate a message such as advertising material (see column 7, lines 40-42). If the phrases "first indicator providing a value

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of postage paid” and “establishing a value of postage paid” were given patentable weight, it is known to use printed matter in combination with a sterilization color indicator on an adhesive strip. Therefore, it would have been obvious to one having ordinary level of skill in the art at the time the invention was made to combine a sterilization color indicator with a postage stamp because Rohowetz teaches that it is known to combine a sterilization color indicator with printed matter on a substrate comprising an adhesive backing. Furthermore, one would have found it obvious to combine a postage stamp and an adhesive sterilization indicator for purposes of ease of use and long-term economics.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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5. Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koenck et al. (Patent Application Publication US 2002/0162971 A1) in view of Hori et al (U.S. Pat. 3,899,677).

Koenck et al. disclose a system and method for irradiating and sterilizing mail articles that may be contaminated (see paragraphs [0058] to [0083]). The method comprises first collecting mail from "blue boxes" and individual residential mailboxes, then transporting the postal material to the post office, and finally sterilizing the mail at the post office prior to delivery of the mail to the recipients. Although the reference does not specifically disclose the step of affixing a postage stamp to the mail article it is implied that mail which has been collected by postal workers will have the proper postage stamp since postage is required in order for the mail to be delivered by the post office.

The system disclosed by Koenck et al. comprises a sterilization apparatus which has a means to sterilize a mail article using e-beam sterilization. Also, it is disclosed that other sterilizing means are available such as x-rays or gamma radiation. However, the method and system of Koenck et al. does not teach a sterilization indicator affixed to the mail articles for indicating that the sterilization process is complete.

Hori et al. discloses a plastic film that changes color in response to a radiation dose. The plastic film has been developed for measuring and controlling the irradiation exposure during the sterilization of articles such as medical instruments and foodstuffs. Specifically, the coloring agents in the plastic film change color when irradiated during the sterilization process (see column 1, lines 15-35). The coloring agents are mixed with a plasticizer and a polymer and then coated onto a carrier such as a plastic film, a paper coated

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with plastic, or a metallic foil such as aluminum foil, and thereafter dried by heating (see column 3, lines 38-43 and lines 50-60).

Additionally, the carrier may be provided with an adhesive layer such as a pressure sensitive adhesive (see column 4, lines 10-15). It would have been obvious to one of ordinary level of skill in the art at the time the invention was made to modify the invention of Koenck et al. and include the adhesive chemical indicator strip taught by Hori et al. affixed to the mail articles, since Hori et al. teaches that it is known to adhere a color changing chemical indicator strip to an article being sterilized in order to determine when the article has received a predetermined amount of radiation in a sterilization process.

Moreover, the phrases "first indicator providing a value of postage paid" and "establishing a value of postage paid" are not given any patentable weight because the claim language refers to the pictures or markings/printing on a material and these features are not held to be patentable (see M.P.E.P. 706.03(a)). Therefore, the claims have been interpreted to include any adhesive color changing indicator strip capable of indicating when an article has been properly sterilized.

6. Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koenck et al. in view of Lewis et al. (U.S. Patent No. 5,084,623).

Koenck et al. disclose a system and method for irradiating and sterilizing mail articles that may be contaminated (see paragraphs [0058] to [0083]). The method comprises first collecting mail from "blue boxes" and individual residential mailboxes, then transporting the postal material to the post office, and finally sterilizing the mail at the post office prior to delivery of the mail to the recipients. Although the reference does not specifically disclose the

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step of affixing a postage stamp to the mail article it is implied that mail which has been collected by postal workers will have the proper postage stamp since postage is required in order for the mail to be delivered by the post office.

The system disclosed by Koenck et al. comprises a sterilization apparatus which has a means to sterilize a mail article using e-beam sterilization. Also, it is disclosed that other sterilizing means are available such as x-rays or gamma radiation. However, the method and system of Koenck et al. does not teach a sterilization indicator affixed to the mail articles for indicating that the sterilization process is complete.

Lewis et al. disclose a multi-ply radiation dosage indicator that changes color upon being irradiated. This serves to provide a visual indication as to whether the substrate to which the indicator is attached has been exposed to a radiation dosage exceeding a predetermined threshold (see column 2, lines 55-64). The indicator **10** is formed as a multi-ply laminate including a first ply **12** having visible indicia **14** thereon. The indicia, as shown, represents letters forming the word "NOT". A second ply **16** of transparent material is provided which defines a radiation sensitive surface **18** disposed in overlying relation to the indicia **14** of the first ply **12**. The radiation sensitive zone **18** is capable of changing opacity in response to exposure to radiation exceeding a predetermined threshold so as to change visibility of indicia **14**. Suitable for use as a second ply **16** are films of a radiation sensitive polyacetylenic system that provides a color change. A third ply **20** may be provided in overlying relation to plies **12** and **16**. The third ply **20** is formed having a viewing zone in the form of a cut-out **22** positioned to permit exposure of indicia **14**. Ply **20** also has visible readable indicia **24** thereon positioned adjacent viewing zone **22**. The indicia **24** represents letters forming the word

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"IRRADIATED". Together the indicia **14** and **24** together provide a visual readable indication as to whether the indicator has been exposed to a radiation dosage exceeding the predetermined threshold (see col. 4, line 43-col. 5, line 14). In order to permit the indicator **10** to be attached to a substrate or other object being subjected to radiation, a pressure sensitive adhesive ply **30** is applied to the bottom of first ply **12** (see column 6, lines 42-48 and figures 1-4). Lewis et al. further disclose an example of irradiating a blood bag. The indicator strip is attached to the blood bag prior to irradiation and the strip reads "NOT IRRADIATED". The bag is then irradiated until the radiation dosage reaches a predetermined threshold and the indicator strip changes color so as to read "IRRADIATED" (see column 5, lines 15-33).

It would have been obvious to one of ordinary level of skill in the art at the time the invention was made to modify the invention of Koenck et al. and include the adhesive chemical indicator strip taught by Lewis et al. affixed to the mail articles since Lewis et al. teaches that it is known to adhere a color changing chemical indicator strip to an article being sterilized in order to determine when the article has received a predetermined amount of radiation in a sterilization process.

As to the phrases "first indicator providing a value of postage paid" or "establishing a value of postage paid," these limitations are not given any patentable weight because the claim language refers to the pictures or markings on a material and these features are not held to be patentable (see M.P.E.P. 706.03(a)). Therefore, the claims have been interpreted to include any adhesive color changing indicator strip capable of indicating when an article has been properly sterilized.

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It is further submitted that sending through the U.S. Postal System any container of sterilization indicators (as would occur when ordering sterilization indicators from a supplier) would render obvious claims 13 and 14.

Response to Arguments

7. Applicant's arguments filed 15 March 2004 have been fully considered but they are not persuasive.
8. Although the case law submitted by Applicant has been carefully reviewed, it does not overcome the rejection under 35 U.S.C. 102 (b), since an adequate functional relationship between the printed matter and the mail article has not been established.
9. With respect to Applicant's argument equating *In re Miller* with the present invention, the decision in this particular case was directed to the propriety of a rejection under 35 U.S.C. §101 and did not address a §102 or §103 rejection. As the instant claims are not rejection under §101, *In re Miller* is not particularly relevant to the issues at hand.
10. As to *In re Levin*, this decision is not published and thus, is not precedent. Regardless, this decision like that in *In re Miller* deals with the propriety of a rejection under 35 U.S.C. §101, not rejections under §102 or §103.
11. The Court previously held in *In re Gulack* that where the printed matter depends on the underlying object in a structural sense, it must be given weight. The most recent case law addressing the issue of a rejection of printed matter under 35 U.S.C. §102 is *In re Ngai*, appeal no. 03-1524, slip opinion, (Fed. Cir., Mar 8, 2004), made precedential, May 13, 2004. In *In re Ngai*, the Court stated that the printed matter (a set of instructions in a kit for normalizing and

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amplifying an RNA population) did not depend on the kit and the kit did not depend on the printed matter. In other words, although there was a textual functional relationship between the printed matter and the underlying object, there was no structural functional relationship.

This is the case with the instant invention and claims. The functional relationship between the printed matter (the stamp postage) and the underlying object (the mail article) is merely textual.

Conclusion

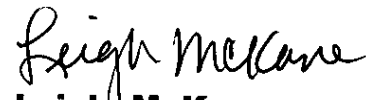
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leigh McKane whose telephone number is 571-272-1275. The examiner can normally be reached on Monday-Wednesday (7:15 am-4:45 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert J. Warden can be reached on 571-272-1275. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Leigh McKane
Primary Examiner
Art Unit 1744

elm
15 June 2004